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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/332,863	06/15/1999	TERESITA VERGARA IMPERIAL	REV-99-10	3442

7590 10/03/2002

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EXAMINER
MRUK, BRIAN P

ART UNIT	PAPER NUMBER
1751	16

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Offic Action Summary	Application N . 09/332,863	Applicant(s) IMPERIAL, TERESITA VERGARA
	Examiner Brian P Mruk	Art Unit 1751

-- *The MAILING DATE of this communication appears on the cover sheet with the c rrespondence address* --

Peri d for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 June 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disp sition of Claims

4)☒ Claim(s) *25-98* is/are pending in the application.

4a) Of the above claim(s) *69-97* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *25-68 and 98* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. This Office action is in response to Applicant's amendment filed June 11, 2002. By amendment, applicant has amended claims 25, 28-29, 33, 35, 49 and 54. New claim 98 has been added. Claims 69-97 remain nonelected. Currently, claims 25-98 remain pending in the application.

2. The text of those sections of Title 35 U.S. Code not included in this action can be found in the prior Office action, paper no. 13.

3. The objection of claims 28-31 and 35-40 is withdrawn in view of applicant's amendments and remarks.

4. The rejection of claims 33-40, 49 and 54 under 35 U.S.C. 112, second paragraph, is withdrawn in view of applicant's amendments and remarks.

5. The rejection of claims 25, 59 and 60 under 35 U.S.C. 102(b) as being anticipated by Henkel, DE 2,624,690, is maintained for the reasons of record.

6. The rejection of claims 26-42 under 35 U.S.C. 103(a) as being unpatentable over Henkel, DE 2,624,690, is maintained for the reasons of record.

7. The rejection of claims 25-47, 50-53 and 55-68 under 35 U.S.C. 102(a) as being anticipated by Goldwell, DE 19721785, is maintained for the reasons of record.

8. The rejection of claims 48-49 under 35 U.S.C. 103(a) as being unpatentable over Goldwell, DE 19721785, in view of Yoshihara, U.S. Patent No. 5,332,581, is maintained for the reasons of record.

NEW GROUNDS OF REJECTION

Claim Rejections - 35 USC § 112

9. Claim 54 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 54 recites the limitation "wherein said alkoxilated alcohol" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. The examiner suggests that the term "alkoxilated" should be changed to "alkoxylated" to provide proper antecedent basis. Appropriate correction and/or clarification is required.

Claim Rejections - 35 USC § 102

10. Newly added claim 98 is rejected under 35 U.S.C. 102(a) as being anticipated by Goldwell, DE 19721785, for the reasons of record found in the previous Office action, Paper No. 13.

Response to Arguments

11. Applicant's arguments filed June 11, 2002 have been fully considered but they are not persuasive.

Applicant argues that Henkel, DE 2,624,690, does not teach or suggest in general that the components are mixed together just prior to application to the hair. However, the examiner asserts that the newly added limitaion "wherein said components are mixed together just prior to application to the hair" in instant claim 25 is a product by process limitation. Thus, the examiner asserts that the subject matter would have been obvious to the skilled artisan because the patentability of a product by process claim does not depend on its method of production and where the examiner has found a similar product, the burden rests with the applicant to prove that that product is patentably distinct. See In re Thorpe, 227 USPQ 964 (CAFC 1985); In re Marosi et al, 218 USPQ 289; In re Pilkington, 162 USPQ 145. "The lack of physical description in a product-by-process claim makes the determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the

patentability of the product claimed and not the process that must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 173 USPQ 685,688 (CCPA 1972). Furthermore, the examiner asserts that applicant's claimed composition are the same as those taught by Henkel when they are mixed together.

Applicant argues that Goldwell, DE 19721785, discloses a composition which contains xanthan gum, whereas the current application discloses that a xanthene-based composition is not suitable for use by those with sensitive or chemically treated hair. However, the examiner asserts that the claims, as presently written, do not exclude xanthan gum.

With respect to the examiner's combination of Goldwell and Yoshihara, applicant argues that these references are unrelated. In response to applicant's argument that Goldwell and Yoshihara are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Goldwell and Yoshihara are in the field of hair care, and thus are clearly analogous.

Furthermore, the examiner asserts that the selection of silicone oils is an obvious variant of Goldwell's teachings since such oils are conventionally used in care hair products, and have the added benefit of conditioning the hair, as taught by Yoshihara.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Mruk whose telephone number is (703) 305-0728. The examiner can normally be reached on Monday-Thursday from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (703) 308-4708. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 **(Before Final)** and (703) 872-9311 **(After Final)**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

BPM
Brian Mruk
September 12, 2002

YOGENDRA N. GUPTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700